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10/561,503	12/19/2005	Satoshi Harai	58946US004	6419
33692 7590 05/13/2010 3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427				
EXAMINER NORDMEYER, PATRICIA L				
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SATOSHI HARAI

Appeal 2009-003848
Application 10/561,503
Technology Center 1700

Decided: May 11, 2010

Before MICHAEL P. COLAIANNI, BEVERLY A. FRANKLIN,
and KAREN M. HASTINGS, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 11, 13-16, and 21-26. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We REVERSE.

Claim 21 is illustrative:

21. A double-sided pressure-sensitive sheet comprising, in the following order, a first pressure-sensitive adhesive layer, a first black layer, a flexible base layer, a second black layer, and a second pressure-sensitive adhesive layer, wherein said first pressure-sensitive adhesive layer and second pressure-sensitive adhesive layer are the outermost layers on either side of the double-sided pressure-sensitive sheet, and wherein the thickness of the double-sided pressure-sensitive sheet is no greater than 60 μm .

Appellant appeals the following rejection:

Claims 11, 13-16, and 21-26 under 35 U.S.C. § 102(b) as anticipated by JP '663 (JP 2002-23663 published Jan. 23, 2002) (as translated).

ISSUE

Did the Examiner err in finding that JP '663 describes first and second black layers arranged as recited in independent claims 21 and 22?

We answer this question in the affirmative.

PRINCIPLES OF LAW

“[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations *arranged or combined in the same way as recited in the claim*, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008) (emphasis added).

In order to anticipate, a reference must identify something falling within the claimed subject matter with sufficient specificity to constitute a

description thereof within the purview of § 102. *In re Schaumann*, 572 F.2d 312, 317 (CCPA 1978).

ANALYSIS
with Factual Findings

Appellant argues that the Examiner has not shown how JP '663 identically discloses the first and second black layers as recited in the multi-layered double sided pressure sensitive sheet of either independent claim 21 or claim 22 (App. Br. 8-11). We agree.

The Examiner's repeated reliance on "(Page 5 of the translation, Paragraph 0011, lines 10-27)" for both the first and second black layers (Ans. 3, 4, 5), when that portion of the reference only broadly discloses that black or white pigment may be added to an adhesive layer or protective layer, does not satisfy the claim limitations at hand for at least the reasons explained by Appellant (App. Br. 8-11; Reply Br. 5). The Examiner's further explanation that "additional layers *may* be present in the construction of the double sided adhesive, which allows the black layer and the adhesive layer being two distinct layers" (Ans. 5, emphasis added) only highlights that JP '663 does not describe the multi-layered structure therein with sufficient specificity to anticipate the claims.

The Examiner in the present case has not based any rejection for our review on a theory that locating first and second black layers as claimed would have been obvious to a person having ordinary skill in the art at the time of Appellant's invention in view of the prior art, and thus we take no position on this issue in the present opinion. *See, e.g., Ex Parte Frye*, No. 2009-006013, 2010 WL 889747, *3 at *6 (BPAI) (Precedential) ("Our decision is limited to the finding before us for review.").

DECISION

We reverse the Examiner's § 102 rejection.

ORDER

REVERSED

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